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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,244	02/19/1999	STEFAN BREUNIG	022701-803	2643

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EXAMINER

MOORE, MARGARET G

ART UNIT PAPER NUMBER

1712

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/202,244

Applicant(s)

BREUNIG ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23 to 25, 27 to 34, 36 to 40, 42 and 46 to 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23 to 25, 27 to 34, 36 to 40, 42 and 46 to 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 47 is rejected under 35 U.S.C. 102(b) as being anticipated by Bailey.

Bailey teaches a process for the hydrosilylation of a compound in the presence of a heterogeneous catalyst. Note Example 15, on the bottom of column 12, which shows a reaction between a synthon as required by claim 47 and a polyorganohydrosiloxane in the presence of a platinum on alumina catalyst. Bailey subsequently devolatilizes the oil. With regards to the claim language of a heterogeneous catalyst to reduce reactions that can form gum and/or resin during devolatilization, the Examiner notes that this is an inherent property associated with the heterogeneous catalyst and thus this is met by the teachings of Bailey.

Applicants traverse this rejection by stating that Bailey reacts a silane rather than a polyorganosiloxane. However the formula on line 66 indicates that the reactant has 3 Si atoms and is, in fact, a siloxane. Note that claim 47 is not limited by the formula (XVI) found in claim 46. Since there is, in fact, a siloxane reactant in Example 15, this rejection is maintained.

4. Claims 23 to 25, 27 to 34, 36 to 40, 42, 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey.

The teachings of Bailey have been noted supra. The only difference between Example 15 in Bailey and that claimed is that the polyorganohydrosiloxane in Bailey does not meet formula XVI or XVII. The sum of corresponding "a" and "b" in units in this example 2, while these claims require a total of greater than 5 up to 200. However as can be seen from lines 25 to 35 on column 2, the siloxanes in Bailey embrace those required by the claims and the selection of "n" in Bailey will obviously be a correlation of the end product utility. Thus one having ordinary skill in the art would have found the selection of a polyorganohydrosiloxane meeting the formula of claim XVI or XVII from the teachings of Bailey to have been obvious and well within experimentation. With regards to the claim language providing a heterogeneous catalyst composition to reduce reactions that can form gum and/or resin during devolatilization, the Examiner notes that this will inherently be met by the use of the heterogeneous catalyst. No selection of a particular catalyst is required in the teachings of Bailey to meet this claim limitation.

Note that the epoxy reactant in Bailey meets that of claims 24, 25 and 27. Note too that column 3, lines 10 to 15, teach an amount of catalyst on the support as found in claim 30. Adjusting the total amount of catalyst in the reaction mixture is within the skill of the ordinary artisan, in an effort to determine the optimum amount of catalyst. As such the limitations of claim 31 would have been obvious. Note that in Example 15, the reaction temperature and time meet that in claim 39, while Bailey removes the catalyst prior to devolatilization, meeting step (e) in claim 39.

Applicants' response does not address this rejection. As such, it is maintained.

5. Claims 34 and 36 to 38 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Crivello et al.

These claims are product by process claims. When reading the process limitations into these product claims, the silicone oil must have reduced reactions that can form a gum and/or resin. Other than this limitation, this product by process claim is

limited only by its structural formula. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Crivello et al. teach a method of making an epoxy siloxane by means of hydrosilylation. This process differs from that claimed in that it does not teach the heterogeneous catalyst as claimed. However it does teach that the catalyst used therein results in a final product that does not gel. See the various examples in Crivello et al. Thus while the processes are different, the Examiner is of the position that the products per se are inherently the same.

Applicants' response details the requirements of an inherency rejection. The Examiner is well aware of these requirements. Applicants emphasize the Examiner's use of the term "appears" but they are reading too much into the language used in the rejection and not enough into the teachings of the patent or the rejection per se. That is, structurally, the final structure of the polymer claimed and the polymer in the prior art are the same. Applicants' process requires that the product be nonturbid and have a stable viscosity. These properties are found in the product in Crivello et al. No difference between the products can be found. While there is a difference in the processes by which the products are prepared, one can conclude that the final products are inherently the same. The Examiner is NOT implying that the inherency is a possible result. The structures are the same. The final properties of the polysiloxanes are the same. This clearly indicates that the products are necessarily the same. There is in fact nothing that would lead one to believe that the products would be different. As such the Examiner maintains that the products are inherently the same.

Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. Appli-

cants have not met this burden and in fact have provided no arguments to indicate that the products are not inherently the same. As such this rejection is maintained.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 23 to 25, 27 to 34, 36 to 40, 42 and 46 to 48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 16 of U.S. Patent No. 6,545,115. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process in '115 requires a heterogeneous catalyst and a polyorganohydrosiloxane, while the unsaturated monomers include synthons such as claimed. Applicants have opted to not respond to this rejection at this time. As such it is maintained.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
6/22/04